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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/759,904

01/16/2004

Eric J. Beckman

02-012

1518

29883

7590

05/17/2006

BARTONY & HARE
LAW & FINANCE BUILDING, SUITE 1801
429 FOURTH AVENUE
PITTSBURGH, PA 15219

EXAMINER

ROGERS, JAMES WILLIAM

ART UNIT

PAPER NUMBER

1618

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/759,904		BECKMAN ET AL.	
	Examiner		Art Unit	
	James W. Rogers		1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-103 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-39, drawn to a biodegradable and biocompatible polyurethane composition, classified in class 424, subclass 78.27.
- II. Claims 40-58, drawn to a method of synthesizing a bone tissue engineering scaffold, classified in class 424, subclass 549.
- III. Claims 59-68, drawn to a method of delivering a bioactive agent into an organism, classified in class 604, subclass 21.
- IV. Claim 69, drawn to an implant for insertion into an organism, classified in class 424, subclass 423.
- V. Claims 70-97, drawn to a biodegradable polyurethane composition comprising hard and soft segments, classified in class 424, subclass 78.17.
- VI. Claim 98, drawn to a composition having the formula drawn in claim, classified in class 522, subclass 97.
- VII. Claim 99, drawn to a composition having the formula drawn in claim, classified in class 564, subclass 414.
- VIII. Claims 100 and 102, drawn to a composition having the formula drawn in claim, classified in class 524, subclass 601.

IX. Claim 101 and 103, drawn to a composition having the formula drawn in claim, classified in class 514, subclass 143.

Inventions I,II,III,IV,VI,VII,VIII and IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have a different mode of operation, design and effect. For instance Invention I is drawn to a biocompatible polyurethane composition while invention II is drawn to a method of synthesizing a bone tissue comprised of human osteoblastic precursor cells, invention III is drawn to a method of delivering a bioactive agent comprised of injecting at least one multifunctional isocyanate and at least one bioactive agent into the organism, invention IV is drawn to an implant for insertion into an organism, the implant being formed external to the organism and inventions VI-IX are claims directed to compositions each claiming a different compound.

Inventions II,III,IV,V,VI,VII,VIII and IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have a different mode of operation, design and effect. For instance invention II is drawn to a method of synthesizing a bone tissue comprised of human osteoblastic precursor cells, invention III is drawn to a method of delivering a bioactive agent comprised of injecting at least one multifunctional isocyanate and at least one bioactive agent into the organism, invention IV is drawn to

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an implant for insertion into an organism, the implant being formed external to the organism, invention V is drawn to a biodegradable polyurethane composition comprising hard and soft segments and inventions VI-IX are claims directed to compositions each claiming a different compound.

Inventions I and V are related as products which share an disclosed common utility linked to a substantial structural feature. The products in this relationship are distinct if either or both of the following can be shown: (1) that the products encompass embodiments that are NOT required to perform the common utility or (2) that the products as claimed encompass embodiments that are NOT required to have the substantial structural feature. In this case, invention V requires a hard and soft segment not required in invention I therefor the two polymeric compositions do not share the same substantial structural feature.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: 1) The various multifunctional isocyanate precursors in claims 12-14,50-54 2) The type of chain extenders in claims 17-18,31,34,39,41,45,58, 62,66 3) The various bioactive agents in claim 48-49 4) The type of injections in claims 63,65,68 5) The various chain extenders in the hard segment in claims 70,73-74,76-86,88,91-91.

Applicant is required under 35 U.S.C. 121 to elect a **single disclosed species** for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims are generic. **Note:** the elected species will name a specific multifunctional isocyanate precursor, chain extender, bioactive agent, type of injection and a specific chain extender in the hard segment.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

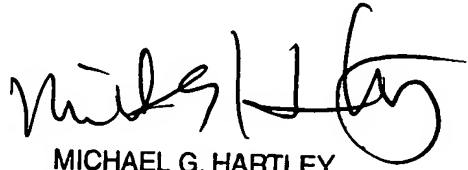
Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER